

REMARKS

Claims 1-49 are pending in this application. The Examiner has rejected:

- 5 (1) claims 1, 2, 4-8, 11, 12, 22-27, 29, 30, 44 and 46-49 under 35 U.S.C. § 103(a); and
(2) claims 47 and 48 under 35 U.S.C. §§ 101 and 112 (second paragraph).

The Examiner has objected to:

- (1) claims 3, 28 and 45; and
(2) the specification.

- 10 The Examiner has withdrawn claims 9, 10, 13-21 and 31-43 from consideration. Applicants are herein amending claims 1, 3, 28, 30, 45, 47 and 48; cancelling claims 9, 10, 13-21 and 31-43, without prejudice; and adding new claim 50.

- 15 Applicants are herein amending claim 1 to more specifically point out that the claim is directed to a cleansing composition. In addition, applicants are herein amending claims 3 and 28 to present them as independent claims, incorporating the limitations of all of the claims from which they each currently depend. Applicants are also herein amending claim 45 to substitute for “comprised of” the more proper transitional phrase of “comprising”. However, applicants have no need to amend this claim to make it
20 independent, as recommended by Examiner, because, as filed, it is an independent claim. In addition, applicants are amending claims 47 and 48 to present them as proper method claims reciting a step. Furthermore, applicants are amending claims 30 and 48, so that there is proper antecedent basis to a “composition” rather than a “system” and a “method” rather than a “composition,” respectively.

25

The Examiner has objected to the specification. However, the Examiner has not specified why he has done so. Thus, applicants have not amended the specification.

- 30 Applicants submit that the amendment to the claims does not introduce new matter and are fully supported by the specification and claims, as originally filed.

Rejection under 35 U.S.C. §§ 101 and 112 (second paragraph)

5 The Examiner has rejected claims 47 and 48 under 35 U.S.C. §§ 101 and 112 (second paragraph) because they are presented as method claims without reciting any active, positive steps. The Examiner has also rejected claim 48 because of improper antecedent basis from claim 47. Applicants have herein amended both claims to properly present them as method of use claims reciting an active step (“the step of providing the composition of claim 1”) and have amended claim 48 to present it as a method claim rather than a composition claim. Applicants submit that these amendments to the claims render the rejections under 35 U.S.C. §§ 101 and 112 (second paragraph) moot and request the Examiner to withdraw the rejections.

Rejection under 35 U.S.C. § 103(a)

15

The Examiner has rejected claims 1, 2, 4-8, 11, 12, 22-27, 29, 30, 44 and 46-49 under 35 U.S.C. §§ 103(a) over US-A-4,980,155 (“*Shah* reference”). The Examiner asserts that the *Shah* reference discloses all of the required elements of applicants’ claimed invention, but lacks sufficient specificity to constitute anticipation. The Examiner further asserts that it would have been obvious at the time the invention was made to one skilled in the surfactant art to make the claimed composition for use in a cleansing composition. Applicants respectfully traverse because the Examiner has failed to establish a proper *prima facie* obviousness rejection of claims 1, 2, 4-8, 11, 12, 22-27, 29, 30, 44 and 46-49, as amended, under 35 U.S.C. §§ 103(a) over *Shah*.

25

To establish a proper *prima facie* rejection, the Examiner must show:

- (1) the references which are available as prior art against the claimed invention;
- (2) the motivation (explicit or implicit) provided by the references that would have rendered the claimed invention obvious to one of ordinary skill in the art at the time of the invention;

30

- (3) a reasonable expectation of success;
- (4) the basis for concluding that the claimed invention would have been obvious to do, not merely obvious to try; and
- (5) the references teach the claimed invention as a whole.

5 Applicants submit that the Examiner has not established elements 2, 3, 4 and 5. If the Examiner fails to establish any one of these elements, he has not made a proper *prima facie* obviousness rejection and the applicants are entitled to a patent. *In re Grabiak*, 769 F.2d 729, 733, 226 U.S. P.Q. 870, 873 (Fed. Cir. 1983).

10 Applicants submit that one skilled in the art would not be motivated explicitly or implicitly, upon reading *Shah*, to select and combine certain ingredients useful as a cosmetic (as defined by Shah at column 2, lines 41-44 to include mascara, foundation, eye shadow, blush, brow product and the like) and use them in personal cleansing applications, and in particular cosmetic removal applications. Applicants submit that there is no
15 motivation to modify the reference to produce applicants' claimed invention.

Furthermore, applicants submit that one skilled in the art would have no expectation that a composition useful as a cosmetic would be useful as a cleanser for these same materials and in a method to cleanse the skin, hair, nails to remove these same
20 materials. In fact, such disclosure teaches away from the usefulness of such compositions for this purpose. *Shah* is silent with respect to the applicability of its compositions as a cleansing composition or in a method of use in personal cleansing applications, and in particular make-up removal applications. If anything, one would expect that adding addition cosmetic material would be highly undesirable and only exacerbate the problem of
25 removing the same cosmetic material. The composition disclosed by *Shah* is designed to present and deposit cosmetic -- not to remove it (column 2, lines 39-41).

Both the suggestion to make the claimed combination and the reasonable expectation of its success must be found in the prior art and not in applicants' disclosure.

In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Applicants submit that neither the suggestion nor the reasonable expectation of success are found in *Shah*.

Moreover, applicants submit that it would not have been obvious that the compositions disclosed by *Shah* would be useful in cleansing compositions or in methods of cleansing, as claimed by applicants. As explained above, one skilled in the art would not have expected a composition used as a cosmetic to be useful to a composition and in a method to remove a cosmetic. Applicants submit that the Examiner is applying an improper "obvious to try" standard under 35 U.S.C. § 103. *In re Geiger*, 815 F.2d 686, 688, 2 U.S.P.Q. 1276, 1278 (Fed. Cir. 1987).

Finally, applicants submit that the Examiner is improperly relying on information gleaned from applicants' disclosure in hindsight to reconstruct applicants' claimed invention. *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678-679, 7 U.S.P.Q. 2d 1315, 1318 (Fed. Cir. 1988). *Shah* is silent with respect to using select ingredients provided in its disclosure to form a cleansing composition. It is the Examiner who, in hindsight using the applicants' disclosure as a blueprint, is improperly reconstructing applicants' claimed cleansing composition and method from the cosmetic compositions of *Shah*.

In view of the foregoing arguments, applicants submit that the Examiner has failed to establish a proper *prima facie* obviousness rejection and, therefore, request the Examiner to withdraw the rejection claims 1, 2, 4-8, 11, 12, 22-27, 29, 30, 44 and 46-49, as amended, under 35 U.S.C. §§ 103(a) over *Shah*.

Allowable Subject Matter

The Examiner has objected to claims 3, 28 and 45 as depending from a rejected base claim but has indicated that each would be allowable if rewritten in independent form, including all of the limitations of the base and intervening claims, and to delete all non-

elected subject matter. Applicants are herein amending claims 3 and 28 to present them as independent claims, incorporating the limitations of all of the claims from which they each currently depend. However, applicants have no need to amend this claim to make it independent, as recommended by Examiner, because, as filed, it is an independent claim.

- 5 Applicants request that the Examiner to rejoin the non-elected subject matter and pass claims 3, 28 and 45 to allowance at this time.

Conclusions

10 Applicants request the Examiner to:

- (1) enter the amendment; and
- (2) reconsider and withdraw the rejection and objections to the claims and specification; and
- (3) pass claims 1-8, 11, 12, 22-30 and 44-50 to allowance.

15 If the Examiner is of a contrary view, the Examiner is requested to contact the undersigned attorney at (215) 557-3861.

Attached hereto is a marked-up version of the changes made to the specification and the claims by the current amendment. The attached page is captioned "VERSION
20 WITH MARKINGS TO SHOW CHANGES MADE."

Respectfully submitted,

25 

Wendy A. Choi
Registration No. 36,697

30 Date: December 27, 2001
WOODCOCK WASHBURN LLP
One Liberty Place - 46th Floor
Philadelphia, PA 19103
Telephone : (215) 568-3100

DOCKET NO.: JBP-508 USA

PATENT

9

Facsimile : (215) 568-3439

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

5 Please delete claims 9, 10, 13-21 and 31-43, without prejudice.

Please amend claims 1, 3, 28, 30, 45, 47 and 48 as follows:

1. (amended) A [foaming] cleansing composition, comprising:
- (a) a water dispersible component;
- (b) an ester;
- (c) water; and
- (d) a foaming surfactant.
3. (amended) [The composition of claim 1 further comprising] A cleansing composition, comprising:
- (a) a water dispersible component;
- (b) an ester;
- (c) a foaming surfactant;
- (d) water; and
- (e) a liquid silicone.
28. (amended) [The composition of claim 26] A cleansing composition, comprising:
- (a) a water dispersible component;
- (b) an ester;
- (c) a foaming surfactant;
- (d) water; and
- (e) a cleansing enhancer selected from the group consisting of a nonfoaming surfactant, non-ionic emulsifiers and mixtures thereof;

wherein the non-ionic emulsifier is selected from the group consisting of isoceteth 20, oleth-2, mixture of PEG-40 hydrogenated castor oil and trideceth-9, Poloxamer 184, laureth-4, sorbitan trioleate, polyoxyethylene-(2) oleyl ether, sorbitan stearate, cetearyl glucoside, glyceryl oleate, and mixtures thereof.

5

30. (amended) The [system] composition of claim 22 wherein the benefit agent is selected from the group consisting of feverfew, centella asiatica, olive leaf, wheat protein, oat oil, lycopene, DMAE, soy and derivatives thereof, colloidal oatmeal, sulfonated shale oil, elubiol, 6-(1-piperidiny)-(2,4-pyrimidinediamine-3-oxide, finasteride, ketoconazole, salicylic acid, zinc pyrithione, coal tar, benzoyl peroxide, selenium sulfide, hydrocortisone, sulfur, menthol, pramoxine hydrochloride, tricetylammonium chloride, polyquaternium 10, panthenol, panthenol triacetate, vitamin A and derivatives thereof, vitamin B and derivatives thereof, vitamin C and derivatives thereof, keratin, lysine, arginine, hydrolyzed wheat proteins, hydrolyzed silk proteins, octyl methoxycinnamate, oxybenzone, minoxidil, titanium dioxide, zinc oxide, retinal, erythromycin, tretinoin, and mixtures thereof.

10

15

45. (amended) A [foaming] cleansing composition [comprised of], comprising:

- (a) water;
- 20 (b) a water dispersible component selected from the group consisting of hexylene glycol, PEG-6 caprylic/capric triglycerides, and mixtures thereof;
- (c) an ester selected from the group consisting of isononyl isononanoate, isostearyl palmitate, cetyl octanoate, pentaerthritol tetraoctanoate, and mixtures thereof; and
- 25 (d) a foaming surfactant selected from the group consisting of cocamide MEA, lauryl glucoside, PEG-50 tallow amide, cocamdopropylamine oxide, and mixtures thereof.

30

47. (amended) [The use of the composition of claim 1] A method of use in a personal care product, comprising the step of:

providing the composition of claim 1.

48. (amended) The [composition] method of claim 47, wherein the personal care product is
in the form of a gel, a bath, a wash, a mousse, a shampoo, a rinse, a lotion, a cream,
5 a wipe, a brush, a sponge, or a spray.

Please add the following new claim:

50. A method of cleansing skin, hair or nails, comprising the step of:
10 applying to said skin, hair or nails, the composition of claim 1 or claim 3.